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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,340

08/31/2006

Kai Rossen

7601/88254

9531

66991

7590

10/08/2008

LAW OFFICE OF MICHAEL A. SANZO, LLC
15400 CALHOUN DR.
SUITE 125
ROCKVILLE, MD 20855

EXAMINER

LOEWE, SUN JAE Y

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

10/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,340	Applicant(s) ROSSEN ET AL.	
	Examiner SUN JAE Y. LOEWE	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 5-24 are pending in the instant application.

Response to Amendment

2. The claim amendments filed on July 21, 2008 have been fully considered. The 35 USC 112 2nd paragraph rejection has been obviated and is thus hereby withdrawn.
3. The remarks filed on July 21, 2008 have been fully considered, however, they are not found to be persuasive in overcoming the previously made 35 USC 103 rejection. This ground of rejection is maintained and made FINAL.

Claim Objections

4. Claims 5-24 remain objected to for containing non-elected subject matter (see office action dated April 21, 2008).

Claim Rejections - 35 USC § 103

5. Below are responses to Applicant's remarks:

- a) “ The presently claimed process is carried out in a one phase solvent system and relies on rapid precipitation to protect the ketoproline products made. As discussed on page 4 of the application, lines 8-15, the process requires that precipitations occur rapidly after reaction, preferably immediately. This is why the present claims require that the ketoproline product be induced to crystallize at the same time that oxidizing agent is being added to the system.

Overall, Applicants submit that a main element required by the pending claims, stabilization of ketoproline products by inducing precipitation at the same time that oxidizing agent is added, is not suggested by any of the references cited and, even if the references are combined, this element is totally lacking. ”

Pursuant MPEP 2144.04.IV, the noted limitation (ie. order of addition of ingredient) is not deemed to impart patentability to the claimed process.

- b) “ Although Riley uses a one phase system, ketoprofens are not among the oxidation products considered and it is not clear that stability problems of the same degree exist for the compounds studied. Moreover, the products in Riley were analyzed directly in solution and not precipitated or otherwise purified (see footnote on page 1531). ”

Pursuant MPEP 2143.E, a person of ordinary skill has good reason to pursue “the known options within his or her technical grasp.” It is maintained that the combined disclosure of the cited references suggests to one of ordinary skill to make the modification necessary to practice the instant invention with reasonable expectation of success.

- c) “ Although the Examiner alleges that Narukawa teaches that ketoprofens are not very soluble in water, Applicants have been unable to find such a teaching in the reference. Even if present, it is not clear how this would serve as a motivation to actively induce precipitation while adding oxidizing agent to protect ketoprofens from unwanted reactions. ”

Applicant is respectfully referred to pg. 549 of the reference, and the guidelines of MPEP 2144.01, excerpts below:

2144.01 Implicit Disclosure

“[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.”

For the reasons provided above, Applicant’s remarks are not found to be persuasive. Therefore, the 35 USC 103 rejection is still deemed proper and hereby made FINAL. Claims 5-24 remain rejected.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUN JAE Y. LOEWE whose telephone number is (571)272-9074. The examiner can normally be reached on M-F 7:30-5:00 Est.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sun Jae Y. Loewe, Ph.D./
9-22-2008

/Kamal A Saeed, Ph.D./
Primary Examiner, Art Unit 1626